

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

### **REMARKS/ARGUMENTS**

#### **Pending Claims**

Claims 1-10 are pending in the application. Of these claims, Claims 1, 6, and 10 are independent claims and the remaining claims are dependent claims. Upon entry of the present Amendment, Claims 1, 6, and 10 will have been amended.

By the present Amendment and Remarks, applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the Office Action and allowance of the present application at the Examiner's earliest convenience.

#### **Summary of the Official Office Action**

##### **Objections**

The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they did not include the following reference sign(s) mentioned in the description: 206.

The disclosure was objected to because of the following formalities: paragraph 0034 refers to reference 206 in Fig 5.

##### **Claim Rejections**

Claims 1-10 were rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook et al. (US PG PUB 2002/0080396).

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

**Response to Objection of Drawings and Specification**

**Drawings/Specification**

In response to the objection that the drawings did not include reference sign 206 mentioned in the description and the objection that the disclosure referred to reference sign 206, per the above Amendments, the disclosure has been amended to refer to reference sign 208 instead of reference sign 206, where reference sign 208 is included in the previously submitted set of drawings.

In lieu of the above Amendments, Applicant respectfully requests the Examiner withdraw the objections to the drawings and specification.

**Traversal of Rejection under 35 U.S.C. 102(b)**

Applicant respectfully traverses the rejection of Claims 1-10 under 35 U.S.C. 102(b) as being anticipated by Silverbrook et al. (US PGPUB 2002/0080396) [hereinafter "Silverbrook"].

Turning to the specific claim language of the present application, independent Claim 1 as amended is directed to a method for recording, on one recording medium, a positional information image representing positional information corresponding to at least positions on the recording medium and the other image, using a recording apparatus that applies a recording material onto the recording medium, the method comprising the step of obtaining information on recording of the positional information image according to record data for recording the positional information image, the correction step of correcting record data of said the other image so that a predetermined recording property

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

of said the other image is varied, according to the obtained information and the recording step of recording the positional information image and said the other image corrected, by applying a visible recording material on the recording medium.

The present invention of independent Claim 1 describes controlling color changes when a positional information image and the other image are recorded on a recording medium. In particular, image data of the other image recorded in a particular region of the recording medium is corrected according to the information related to the recording position of the positional image. In addition, the present invention of independent Claim 1 also describes recording both the other image and the positional information image by applying a visible recording material.

Applicant respectfully submits that Silverbrook fails to disclose at least the above-noted features of the present invention.

Silverbrook is seen to describe a system for producing interface surfaces ("netpages") which allow users to interact with networked information and to obtain interactive printed matter. More specifically, a "netpage" consists of a printed page (or other surface region) invisibly tagged with references to an online description of the page. The tags may be printed on or into the surface of the page, may be in or on a sub-layer of the page or may be otherwise incorporated into the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system (paragraph 0148).

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

Tags are printed in infrared-absorptive ink on any substrate which is infrared-reflective, such as ordinary paper (paragraph 0151). A tag is sensed by an area image sensor in the netpage pen, decoded and the data encoded by the tag is transmitted to the netpage system, preferably via the nearest netpage printer. Tags are sufficiently small and densely arranged that the pen can reliably image at least one tag even on a single click on the page. It is important that the pen recognize the tag and extract the page ID and position on every interaction with the page, since the interaction is stateless. Tags are error-correctably encoded to make them partially tolerant to surface damage (paragraph 0152).

In a preferred form, each tag identifies the region in which it appears, and the location of that tag within the region. A tag may also contain flags which relate to the region as a whole or to the tag. One or more flag bits may, for example, signal a tag sensing device to provide feedback indicative of a function associated with the immediate area of the tag, without the sensing device having to refer to a description of the region. A netpage pen may, for example, illuminate an "active area" LED when in the zone of a hyperlink (paragraph 0155).

As the above referenced sections of Silverbrook illustrate, Silverbrook discloses the structure to detect a tag, printed on a recording medium with invisible ink, by a sensor on a pen. The position on the surface of the recording medium can be determined by reading the tag using the pen. The disclosed tag comprises at least 90 bits of region ID (paragraph 0158), which itself shows the position on the recording medium. In other words, encoded information showing the position on the recording medium is already included in the tag.

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

Nothing in Silverbrook is seen to disclose or describe recording a positional information image. As indicated above, each of the tags of Silverbrook contains tag ID information, which can include the position of the tag (e.g., the region on the surface in which the tag appears and the location of the tag within the region). Recording a tag, where the tag contains information regarding the tag's position is not seen to describe recording a positional information image as described in the present invention. In addition, since the tags are printed with invisible ink, Silverbrook is not seen to disclose or describe recording positional information image by applying a visible recording material on a recording medium.

Furthermore, nothing in Silverbrook is seen to disclose or describe correcting the other image data so that a predetermined recording property of the other image is varied according to obtained information on recording of the positional information image.

Silverbrook is only seen to describe (paragraphs 0569 and 0571) the standard processing of a common print engine controller that a printer uses to prepare data for printing. Nothing in either of these paragraphs or in any other section of Silverbrook is seen to disclose correcting the other image data so that a predetermined recording property of the other image is varied according to obtained information on recording of the positional information image.

Because Silverbrook lacks at least the above-noted features of the present invention, Applicant submits that Silverbrook fails to disclose each and every feature recited in Claim 1, and that the Office Action fails to include adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. 102(b). Therefore, Applicant

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

submits that the rejection of at least independent Claim 1 is improper and respectfully requests that the rejection be withdrawn.

Amended independent Claim 6 is directed to a recording system comprising a recording apparatus for performing recording by applying a recording material onto a recording medium according to image data, a transmitter for transmitting the image data to the recording apparatus, preparation means for preparing image data corresponding to an image to be recorded, acquisition means for obtaining information on recording of a positional information image, according to record data for recording the positional information image, the positional information image representing positional information corresponding to positions on the recording medium; and correction means for correcting record data for recording said the other image according to the information obtained by the acquisition means, wherein the recording apparatus records the positional information image and said the other image corrected by the correction means, by applying a visible recording material on one recording medium.

Amended independent Claim 10 is directed to a recording apparatus for forming an image on a recording medium comprising recording means for performing recording by applying a visible recording material onto the recording medium, the recording means recording at least one of a positional information image representing positional information corresponding to the position where the positional information image is recorded and the other image, a control means for controlling the recording such that the recording means records the positional information image with a recording material capable of being detected by a predetermined detector, and said the other image with another recording material incapable of being detected by the detector, and correction

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

means for correcting record data for recording said the other image, according to record data for recording the positional information image.

Amended independent Claims 6 and 10 were rejected for essentially the same reasons as independent Claim 1. As in the case of independent Claim 1, Silverbrook lacks at least the above-noted features of independent Claims 6 and 10, and as such, Applicant submits that Silverbrook fails to disclose each and every feature recited in Claims 6 and 10. Therefore, Applicant submits that the rejections of Claims 6 and 10 are improper and respectfully requests the rejections be withdrawn.

Furthermore, Applicant submits that Claims 2-5 and 7-9 are allowable at least for the reason that these claims depend from either allowable base Claim 1 or allowable base Claim 6 and recite additional features that further define the present invention.

Appl No. 10/716,026  
Response Date: 12/05/2005  
Response to Office Action

CONCLUSION

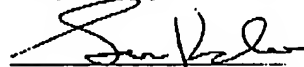
Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability, and respectfully requests the Examiner to indicate the allowance of such claims as the Examiner's earliest convenience.

In view of the foregoing, it is submitted that the reference of record does not anticipate or render obvious the Applicant's invention as recited in Claims 1-10. The applied reference has been discussed and distinguished, while significant claimed features of the present invention have been pointed out. Further, any amendments to the claims which may have been made in this response and which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein is respectfully requested and now believed to be appropriate.

Applicants' undersigned attorney may be reached at (949) 932-3329. All correspondences should be directed to the below-listed address.

Respectfully submitted,



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